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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,003	05/03/2001	Marcus Haley	9227.00	5670
26889	7590	04/19/2007		
MICHAEL CHAN NCR CORPORATION 1700 SOUTH PATTERSON BLVD DAYTON, OH 45479-0001			EXAMINER COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3694	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/19/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/848,003

**Applicant(s)**

HALEY ET AL

**Examiner**

Ella Colbert

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) 22-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-6 and 22-31 are pending. Claim 1 has been amended and claims 22-31 have been newly added in this communication filed 1/24/07 entered as Response After Non-Final and New or Additional Drawings.
2. The Drawing Figure submitted on 1/24/07 is accepted and the amendments have overcome the drawing objections to figure 5 and is hereby withdrawn in part. The objection to drawing figures 4 and 8 still remains as set forth here below.
3. The 35 USC 112 First Paragraph Rejection has been overcome by Applicants' amendment to claim 1 and is hereby withdrawn.
4. The amendments to the Specification have been reviewed and the Specification contains an error. Therefore, the Objection to the Specification remains as set forth here below.

### ***Election By Original Presentation***

5. Newly submitted claims 22-31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 23-31 are directed to relying on the authorization to execute a transaction without obtaining authorization directly from a remote party and a dispenser for dispensing currency, tickets, coupons, or a token or circuit for use in the electronic device carried by a customer in connection with a transaction. Claims 1-6 are directed to receiving a transaction authorization request from the device and receiving a requested transaction from the user's portable electronic device and fulfilling the requested transaction without the terminal preparing an authorization request, and the user's portable device making

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the authorization request to a remote party then transmitting the authorization received in response to the authorization request to a communication port.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-31 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figure 4, reference sign "54" and Figure 8, reference character(s) "40" and "60". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because Figure 8, reference character "42" has been used to designate both "IrDAport"

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and "communication port" and reference character "60" has been used to designate both "IR port" and "port". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

8. The amended Specification is objected to because Page 2, the third line in the fourth paragraph recites "6) required ... for controlling the port". This line should recite "6) required ... for controlling the IR port". Page 1, (2) contains the acronym "DES" and Page 3, line 7 of the original Specification recites "the terminal does not obtain authorization from any device out with itself. The terminal does". This line is unclear as to what Applicants' are trying to say. Page 8, line 11 and Page 9, lines 8 and 12 contain the acronyms "GSM", "EEPROM", and "RAM". It is not understood what "GSM" is the acronym for in line 11 on page 8. Acronyms should be written for example, "Self-service terminal (SST)". Correction is required. See MPEP § 608.01(b).

### ***Abstract***

9. The abstract of the disclosure is objected to because the Abstract contains over

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150 words.

Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

10. Claim 1 is objected to because of the following informalities: claim 1(b) line 6 recites "of a remote party, and transmits authorization ...". This line should recite ""of a remote party, and transmits the authorization ...". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains a clause of intended use in the independent claim which renders the claim indefinite. Specifically, claim 1 (b) recites "wherein the user's portable device makes the authorization request ...".

The Examiner considers this limitation to only recite what is expected to happen, a desired result, or an intended use. The MPEP discusses a type of limitation in reference to "wherein" clauses. MPEP § 2111.04 states:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

Claim 1 recites "device" which is considered indefinite in the claim language because the "device" could be any "device" even though the preamble recites "A self-service terminal". A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over (EPO 933 733 A2) Kwan in view of (US 6,305,603) Grunbok et al, hereafter Grunbok.

As per claim 1. Kwan discloses, A self-service terminal comprising:  
a communication port for interfacing with a user's portable electronic device and for receiving a transaction authorization therefrom (Page 2, col. 2 [0009], Page 3, col. 4 [0013], and Figure 1). Kwan failed to disclose, means for receiving a requested transaction from a user's portable electronic device and for fulfilling the requested transaction without the terminal preparing an authorization request, wherein the user's portable device makes the authorization request of a remote party, and transmits the authorization received in response to the authorization request to the communication port. Grunbok, discloses means for receiving a requested transaction from a user's portable electronic device and for fulfilling the requested transaction without the terminal preparing an authorization request, wherein the user's portable device makes the authorization request of a remote party, and transmits the authorization received in response to the authorization request to the communication port (col. 3, line 66-col. 4, line 35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate in Kwan the teachings of Grunbok because such

an incorporation would allow Kwan to have a faster and more efficient means to transmit an authorization request to a self-service terminal communication port.

As per claim 2. Kwan discloses A self-service terminal according to claim 1, further comprising (i) a dispenser for dispensing items, and (ii) means for cooperating with the dispenser to dispense an item to fulfill the requested transaction without the terminal preparing an authorization request (Page 3, col. 4 [0016] –Page 4, col. 5, line 14).

As per claim 3. Kwan discloses, A self-service terminal according to claim 1, further comprising (i) a storage area for receiving an item inserted by a user, and (ii) means for cooperating with the storage area to receive an item from a user as part of the requested transaction without the terminal preparing an authorization request (Page 3, col. 3 [0012]-col. 4 [0015] and Page 5 [0023]).

As per claim 4. Kwan discloses A terminal according to claim 1, wherein the communication port comprises a wireless communication port (Page 4, col. 5 [0017]-col. 6 [0020]).

As per claim 5. Kwan discloses A terminal according to claim 1, wherein the communication port comprises a physical cradle into which the user's portable electronic device couples (Page 3, col. 4 [0016] –Page 4,col. 5, line 14).

As per claim 6. Kwan discloses, A terminal according to claim 1, further comprising means for storing each transaction authorization for proving that a transaction has been executed (Page 5, col. 7 [0025] –col. 8, line 39).

*Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the Examiner.*

#### **Response to Arguments**

15. Applicants' arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

#### **Inquiries**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 14, 2007

  
ELLA COLBERT  
PRIMARY EXAMINER